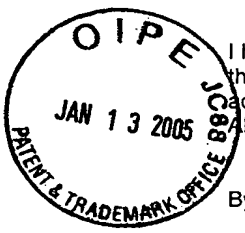


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By: [Signature] January 7, 2005
Aaron T. Borrowman, Reg. No. 42,348

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|---------------------------|
| In re Application of | Group Art Unit: 3611 |
| CHRIS KREUTNER | Examiner: Cassandra Davis |
| Serial No. 09/934,777 | |
| Filed: August 21, 2001 | Docket No. SMART-38766 |
| For: PACKAGING TAPE SYSTEM AND RELATED PROCESS | |

APPELLANT'S BRIEF
(37 CFR §1.192)

MS: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Gentlemen:

This brief is in furtherance of the Notice of Appeal, filed in this case on November 8, 2004. The fees required under §1.17 for filing this brief are submitted herewith. This brief is transmitted in triplicate according to CFR §1.192(a).

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SMART-38766
Serial No. 09/934,777
Appeal Brief

I. REAL PARTY INTEREST

The real party in interest is Smartmove, Inc., a California corporation, pursuant to the October 7, 2002 assignment by Chris Kreutner, the inventor.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that Applicant or his attorney is aware of.

III. STATUS OF CLAIMS

Claim 6-11 and 13-21 are currently pending and presented on appeal. These claims were reproduced in the Appendix, attached hereto.

IV. STATUS OF AMENDMENTS

Applicant filed an Amendment on April 20, 2004 responding to the January 20, 2004 Office Action. All of the amendments in the April 20, 2004 Amendment were entered in the August 13, 2004 Final Office Action. Therefore, the claims presented in the attached Appendix represent the claims as amended and entered.

V. SUMMARY OF INVENTION

The present invention is concerned with a packaging tape system comprising adhesive boxing tape 10 having pre-printed indicia 12 thereon for the purpose of labeling a packed moving box according to the room, housing

area, or office area from which the contents were retrieved/originated or the room in which the contents of the box are destined.

As described in the Background section of the present application, the present invention is intended to overcome the disadvantages associated with using a marker or writing instrument to write the contents of the box or the room from which it was packed on the box itself, or using labels, which comprise a two-step process. Writing on the box, or tape, may present handwriting which is not legible or too small to be seen at a distance. Also, the writing may be smeared by other boxes or the movers themselves. Once a box is written upon, either the box must be packed in the future according to the information previously written on it, or the previous writing must be scratched out. Another problem with using a marking pen is that the marking pen must be purchased in addition to the tape, and that the tape and marking pen must be located with one another at all times. If using labels, the consumer must purchase the labels in addition to the boxing tape. Moreover, the labels are very small rendering them difficult to read at a distance, and must be applied to several surfaces of the box in order that a mover can determine where the box originated without having to look at every side of the box.

The adhesive boxing tape 10 of the present invention is of a length sufficient to extend across a face of a box and seal two flaps of a box in a closed position, and as such is preferably formed in a dispensing roll (page 4, lines 6-8). The indicia 12 which is pre-printed on the tape and serves to label the box can label any box from any room in the house, for example, kitchen, bedroom, bathroom, dining room, living room, garage, storage room, office,

study, den, family room, utility room, etc. Each roll of tape has the indicia printed repeatedly in sequence on the tape so as to indicate the room from which the contents of the box originated. The pre-printed indicia 12 can also relate to rooms and locations of an office, such as a break room, a conference room, a filing room, a reception area, an office, a computer room or department. (Page 4, second full paragraph).

In a preferred embodiment of the invention, each roll of boxing tape 14 is brightly colored to distinguish one room or area from another similar room or area. Thus, different colored tape can be used to identify different rooms with the same description, such as more than one bedroom or bathroom. (Last full paragraph page 4, and extending to page 5). Every roll of tape may be of a different color so as to further assist the movers from distinguishing the boxes of one room from another.

In use, articles 16 from one room or area of the house or office are placed within a moving box, and the appropriate roll of tape 14 bearing the indicia 12 relating to the room or location from which the articles came from is selected and the tape 10 dispensed from the roll 14 and onto the box 18 so as to cover substantially the length of opposing edges 22 of the box flaps 20 in order to simultaneously seal and label the box 18. (Last full paragraph of page 5, extending to page 6).

Instead of throwing away the boxes, or scratching out the old labels or markings, the tape 10 of the present invention is simply removed from the boxes and the boxes may be stored for later use. The present invention also eliminates the need to purchase marking pens, labels, and boxing tape to individually wrap and mark each box. This saves time in packing and loading.

Moreover, the present invention can save a tremendous amount of time when unloading as the movers instantly know which room or location the boxes sealed with the tape are to be placed in the new house or office.

VI. ISSUES

In the Office Action mailed August 13, 2004, the Examiner finally rejected claims 6-11 and 13-21 under 35 U.S.C. §103 as follows:

“ Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams, U.S. Patent 4,557,971 in view of Okisawa, Japanese Patent JP411092722A.

Williams teaches self-adhereable tape comprising a pre-printed message such as “handle with Care” or “Fragile” such that the tape serves not only to seal a carton, but also to communicate a message. Williams also teaches indicia related to the address or destination of the carton. The tape taught by Williams may be dispensed from a tape-dispensing machine (not shown) which automatically moistens the gumming layer 22 and cuts the tape to length. (See column 4, lines 7-17).

Okisawa teaches an adhesive tape 1 with repeated pre printed indicia 2 listing the rooms of a house in a side-by-side arrangement. The destination of the box in which the tape is applied is indicated by marking the already printed destination room with a circle.

It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct address indicia on the tape taught by Williams with a room designations as taught by Okisawa to further define the destination of the seal carton.”

In addition the Office Action mailed on August 13, 2004, the Examiner finally rejected claims 9-11 as follows:

“ Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al., U.S. Patent 5,099,991 in view of Williams and Okisawa. Kitagawa teaches a method of packing electrolytic capacitors within a box comprising the step of providing a box 18,

inserting the electrolytic capacitor 14 within the box 18 of corrugated cardboard with flaps 191, 191, 192, 192. Thereafter, the flaps 191, 191, 192, 192 are closed and the box is closed by known adhesive tapes 20 to seal the box 18. (See column 3, lines 12-31). Kitagawa does not teach tape having preprinted indicia thereon. Williams teaches indicia related to the address or destination of the carton. Okisawa teaches an adhesive tape with repeated pre printed indicia 2 listing the rooms of a house in a side-by-side arrangement. It would have been obvious to one of ordinary skill in the art at the time this invention was made to construct the tape of the package taught by Kitagawa with pre-printed address indicia as taught by Williams to provide a means to indicate the designation of the box. In addition, it would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the tape taught by Kitagawa and Williams with repeating designation indicia as taught by Okisawa to provide a means to further define the destination of the box/package and as a means to provide the indicia extending over the entire length of the tape so that the tape would convey (sic) the same message over the length of the tape.

With respect to claim 10-11, Williams teaches a preprinted address on the tape indicating the designation of the box and Okisawa teaches that the pre-printed designation indicia in the form of names of rooms in general houses in Japan. It would have been obvious to one having ordinary skill in the art at the time this invention was made to have any known room of a house or office printed on the tape to provide a means to identify conventional rooms associated with a house or office."

Moreover, in the Office Action mailed on August 13, 2004, claims 6-8 and 17-20 were finally rejected as follows:

" Claims 6-8 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plummer, U.S. Patent 4,252,258 in view of Williams. Plummer teaches a gang tape dispenser 10 for a multiplicity of dissimilar rolls of pressure sensitive tape 51 selectively usable at the user option. Each roll may bear repeated distinctive symbols and/or color dissimilar from those on the other rolls enabling the user to employ the strip alone or in combination for coding and/or identifying articles.

Although the drawings show numeric indicia on the tape rolls, Plummer teaches that other symbols or combination of symbols may be disposed on the different tape rolls. Plummer also teaches that the rolls may be distinguished from one another by various other means as by different colors, letters or symbols as well as by various colors of tapes imprinted with various symbols. (See column 3, lines 39-63). Plummer does not teach the different symbols on the rolls comprising the names of rooms or locations destinations.

Williams teaches self-adhereable tape comprising a pre-printed message such as "Handle with Care" or "Fragile" such that the tape serves not only to seal a carton, but also to communicate a message. Williams also teaches indicia related to the address or destination of the carton. The tape taught by Williams may be dispensed from a tape-dispensing machine (not shown) that automatically moistens the gumming layer 22 and cuts the tape to length. (See column 4, lines 7-17).

It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the tape dispenser by Plummer with the pre-printed indicia as taught by Williams to provide a means to convey the destination or room contents of the box in which the tape is applied.

With respect to claim 6, Plummer clearly teaches multiple dispensing rolls each being of a distinctive color and having distinctive indicia for identifying an article.

With respect to claims 7 and 8, Williams clearly teaches tape having pre-printed indicia related to the address or destination of the carton. The examiner contends that address or destination corresponds to the claims room indicia. It would have been obvious to print the destination address on the tape whether a street address or room addresses as a means to indicate the destination of the box or carton. In addition, since the specific legend "bedroom, bathroom, kitchen, dining room, living room, garage, storage room, office, study, den, family room, utility room etc." does not provide an unobvious functional relationship with the tape, the indicia or printed matter relating to the specific room is considered to be a design consideration. See *In re Miller*, 418, F2d 1392, 164 USPQ 46 (CCPA 969)."

Furthermore, in the Office Action mailed August 13, 2004, claims 9, 13-16 and 21 were finally rejected as follows:

“ Claims 9, 13-16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al., U.S. Patent 5,099,991 in view of Plummer and Williams. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct process for packing a box taught by Kitagawa with a plurality of different tapes having different symbols and/or colors to provide a means to selectively code each box. In addition, it would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the taped box by Kitagawa and Plummer with the pre-printed indicia as taught by Williams to provide indicia related to the destination of the box after it's be (sic) packed.”

Essentially, the Examiner contends that a person skilled in the art would find it obvious to combine the teaching of Williams which discloses a multiple layered laminated tape having a permeable layer suitable for printing or marking by pen, marker, or the like or for addresses or for stamping of messages such as “Handle with Care” or “Fragile”, with the teachings of Okisawa which teaches tape listing all of the names of rooms in the house such that the destination room can be marked with a writing instrument, with Kiagawa which teaches of method of packing electrolytic capacitors within a box having flaps which are sealed with the tape, and Plummer which teaches a gang tape dispenser having a multiplicity of dissimilar rolls of pressure sensitive tape bearing repeated distinctive symbols and/or colors dissimilar from the other rolls for identifying articles to arrive at the present invention. Applicant respectfully disagrees with the assertion that the combination of these references is proper, would render the invention obvious, and teaches all the limitations of the present invention.

VII. GROUPING OF CLAIMS

The obviousness rejection of claims 7 and 19 is directed to the claim of a single group. Both claims 7 and 19 are independent claims reciting a packaging tape system. Independent claim 17 is directed to a roll of adhesive tape configured to extend across a face of a box and seal two flaps of the box in closed position and having indicia repeatedly pre-printed on the adhesive tape indicating a single room or location in a house (selected from: a bedroom, a bathroom, a kitchen, a dining room, a living room, a garage, a storage room, an office, a study room, a den, a family room, and a utility room) from which contents of the box originated or are destined within another house, wherein the box can be sealed and labeled simultaneously without marking the box or tape with a writing instrument. Claim 19 is also directed to a roll of adhesive tape configured to extend across a face of a box to seal two flaps of a box in a closed position such that the box can be sealed or labeled simultaneously, without marking the box or tape with a writing instrument. However, claim 19 is directed to indicia pre-imprinted on the adhesive tape indicating a single room or location in an office (selected from: a break room, a conference room, a file room, a reception area, an office, a computer and a department) from which the contents of the box originated or are destined within another office. Although the obviousness rejection is directed to both of these claims as a single group, due to the fact that each claim 17 and 19, is directed to a room or area of a house or an office, respectively, Applicant asserts that these claims should stand on their own.

The obviousness rejection of claims 9-11 is directed to these claims in a single group. Claim 9 is an independent claim directed to a process

for packaging articles to be moved, comprised in the steps supplying a moving box having opposed opened flaps, place an article to be moved in the moving box, closing the flaps towards one another, and applying adhesive tape over substantially the length of opposing edges of the closed flaps. To hold the flaps in a closed position, the adhesive tape having indicia repeatedly pre-printed thereon indicated a single room or location from which the articles were taken from within the house or office, or where the box of articles are destined within another house or office, whereby the moving box is sealed and labeled simultaneously without the need for marking the tape or the box with a writing instrument.

The obviousness rejection to claims 6-8 and 17-20 is directed to these claims as a single group. Claims 6 and 17 are independent claims. Claim 6 is directed to a packaging tape system comprising multiple rolls of adhesive tape having a sufficient length to extend across a face of a box and seal two flaps of a box in a closed position. Indicia repeatedly pre-printed on each roll of the adhesive tape along the length thereof indicates a single room or location within a house or office from which the contents of the box originated or destined within another house or office. Each roll is of a distinctive color so as to be readily visibly distinguishable from another roll indicating another room or location within the house or office. The box can be sealed and labeled simultaneously without the marking of the box or tape with a writing instrument. Independent claim 17, as discussed above is specifically directed to indicia repeatedly pre-printed on adhesive tape indicating a single room or location in the house from which the contents of the box originated or are destined within another house.

The obviousness rejections of claims 9, 13-16 and 21 are directed to these claims as a single group. Claim 9 is an independent claim, as described above. Claim 14 is also an independent claim directed to a process for packaging articles to be moved, and includes the recitation that each roll is of a distinctive color so as to be readily visually distinguishable from another roll indicating another room or location of the house or office. Claim 21 is also the process for fastening articles removed from a first house to a second house. It recites the following:

“providing multiple rolls of adhesive tape each having indicia repeatedly printed on a length thereof indicating a single room or location within the house, selected from: a bedroom, a bathroom, a kitchen, a dining room, a living room, a garage, a storage room, an office, a study, a den, a family room and a utility room, wherein each roll is of a distinctive color so as to be readily visually distinguishable from another roll indicating another room or location within the house;

supplying at least one moving box having opposed open flaps;

placing articles within a room of the first house to be moved to the second house into the moving box;

closing the flaps of the box toward one another;

selecting the roll of adhesive tape having the single room repeatedly pre-printed thereon representing the room from the which the articles were taken;

applying the adhesive tape from the selected roll over substantially the length of opposing edges of the closed flaps to hold the flaps in a closed position, whereby the moving box is sealed and labeled simultaneously without the need to mark the tape or the box with a writing instrument; and

delivering the at least one sealed and labeled box from the first house to the second house and placing each sealed and labeled box in a corresponding room in the second house according to the indicia on the adhesive tape sealing the box.”

As each of the independent claims has different recitations and limitations as compared to the other independent claims, Applicant respectfully asserts that each independent claim should stand on its own.

VIII. ARGUMENTS

Rejections Under 35 U.S.C. §103.

Claims 17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Okisawa, Japanese Patent JP411092722A in view of Williams (U.S. Patent No. 4,557,971).

Applicant previously obtained a translation of the Okisawa reference, which was submitted with the April 20, 2004 Response to the January 20, 2004 Office Action.

To establish *prima facie* obviousness of a claimed invention three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed. Cir. 1991)).

As shown in the translated Japanese patent, it is concerned with adhesive tape having a list of names printed thereon for sealing packaging boxes. As shown in drawings 1-4, each roll of tape is printed with a listing of the rooms in side-by-side arrangement. For example, with respect to drawing 1, the following is printed on the tape according to the translation:

| | | | | |
|------------|------------|-------------------|-----------|-------------------|
| Living Rm. | Kitchen | Entrance Bathroom | Illegible | Storage |
| Illegible | Living Rm | Kitchen | | |
| Japanese 1 | Japanese 2 | Japanese 3 | Western 1 | Western 2 Western |
| | | 3 | | |
| Upstairs | Japanese 1 | Japanese 2 | | |

In drawing 3 the following is listed:

| | | |
|----------|----------|----------|
| Locker 1 | Locker 2 | Locker 3 |
| Desk 1 | Desk 2 | Desk 3 |

Once the box is sealed with the tape, the pertinent pre-printed name of the room or other reference character is circled using a writing instrument.

Williams teaches a multiple layered laminated tape having a strength layer and a permeable layer which is suitable for printing or marking. William discloses in column 2, lines 23-28 that the permeable layer may be written on by pen, marker or the like for addresses or for stamping of messages. Williams also teaches self-adhereable tape having "handle with care" or "fragile" stamped thereon.

The present invention resides in a packaging tape system and process for packaging articles to be moved. Claims 17 and 19 have been amended to recite that the adhesive tape has indicia repeatedly pre-printed thereon indicating a single room or location in a house from which the contents

of the box originated or are destined. Moreover, independent claims 17 and 19 have been amended to recite the box can be sealed and labeled simultaneously without marking the box or tape with a writing instrument.

Okisawa, in contrast, pre-prints all of the intended rooms of the house, office, etc. on the tape. In drawing 1, eighteen different designations or rooms are listed. In drawing 3, six different locations or destinations are listed. Drawings 2 and 4 illustrate abbreviations or symbols which can represent multiple different rooms or locations.

Moreover, Okisawa specifically and particularly teaches that a selected room or location is circled with a writing instrument so as to identify the destination of the box. This is expressly contrary to the present invention which does not require a writing instrument, which not only requires a writing instrument and additional steps, but can present the problem of smudging, etc., as disclosed in Applicant's application.

Williams also teaches of utilizing a writing instrument to mark or write upon the permeable tape. The only stamped messages are "handle with care" and "fragile", neither of which indicate a single room or location in an office or house from which the contents of the box originated or are destined.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970).

All the claim limitations of claims 17 and 19 have not been taught or suggested by Okisawa or Williams or the combination thereof. In fact, these

references actually teach away from the claimed invention as the claimed invention recites simultaneously labeling and marking a box without the need for manually marking the tape or box with a writing instrument. The background section of the present patent application discusses the disadvantages of having to manually mark boxes and tape. Instead, claims 17-20 recites a packaging tape system wherein a single room or location is repeatedly printed on the tape so as to be easily seen and not require a writing instrument, which presents legibility concerns and can smudge or accidentally be rubbed off of the tape.

Given the large number of different rooms and locations printed on the Okisawa tape, one would have to be very close and stop to examine the tape and box to determine where the contents originated or where they were destined. Moreover, smudging of the ink of the writing instrument is a well-known problem, further exacerbating the "determination of the destination or origination of the contents of the box when moving." The hand-written markings disclosed by Williams requires the deciphering of one's handwriting, the possibility of smudging the ink, and there is no discussion whatsoever of the rooms or locations within a house or office, as recited in independent claims 17 and 19. Thus, as these references fail to establish all of the claim limitations of these amended claims, *prima facie* obviousness cannot be established and the claim rejections should be withdrawn in light of the amendments.

A prior art reference must be considered in its entirety, i.e., as a whole including portions that would lead away from the claimed invention.

M.P.E.P. §2141.02, citing, W.L. Gore & Associates, Inc. v. Garlock, Inc., 220

USPQ 303 (Fed. Cir. 1983), cert. Denied, 469 US 851 (1984). When considering both the Williams and Okisawa references in their entirety, that is as a whole including portions that would lead away from the claimed invention, Applicant respectfully asserts that the claimed invention as a whole is not obvious.

Claims 9-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kitagawa et al. (U.S. Patent No. 5,099,991) in view of Okisawa. Kitagawa teaches a method of packing electrolytic capacitors within a box. Applicant fails to see the critical elements of the claimed invention which Kitagawa discloses. Applicant respectfully asserts that Kitagawa does not overcome the shortcomings of Okisawa, as discussed above.

Claims 6-8 and 17-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Plummer (U.S. Patent No. 4,252,258) in view of Williams. Plummer teaches a gang tape dispenser for multiplicity of dissimilar rolls of pressure sensitive tape selectively usable at the user option. Plummer discloses that each roll may bear a distinctive symbol and/or color dissimilar from those on the other rolls enabling the user to employ the strip alone or in combination for coding and/or identifying articles.

There is no teaching in Okisawa of distinguishing rooms, for example multiple bedrooms or bathrooms. A mover using the Okisawa tape circled "bedroom" would not know which bedroom the box belonged in the new house. The claimed invention (claims 6-8, 13-16, 18, 20 and 21) preferably utilizes multiple rolls of tape of different color to further enhance and facilitate the distinguishing between boxes quickly and at a distance when moving.

Neither Plummer nor Williams discloses pre-printing indicia repeatedly on each roll of the adhesive tape along the length thereof indicating a single room or location within a house or office. Neither Williams nor Plummer mentions “bedroom, bathroom, kitchen, dining room, living room, garage, storage room, office, study, den, family room, utility room, break room, conference room, file room, reception area, etc.). In fact, neither Williams or Plummer are at all analogous or related to packaging articles to be moved using adhesive tape having pre-printed indicia representing the single room or location within the house or office from which the contents of the box originated or are destined and which simultaneously seals and labels the box without marking the box or tape with a writing instrument.

Although one could mark or write on the tape of Williams, Williams does not disclose the moving and packaging tape system or process of the present invention with any degree of particularity. Moreover, such hand writing and marking is contrary to the claimed invention and presents problems and disadvantages as discussed in the application. Labeling boxes having numeric indicia or other symbols, even if color coded, does not arise to the present claimed invention.

Obviousness is tested by “what the combined teachings of the references would have suggested to those of ordinary skill in the art.” In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But obviousness “cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” ACS Hosp. Sys. Inc. V. Montefiore Hosp., 732 F.2d 1562, 1577, 221 USPQ 929,933 (Fed. Cir. 1984). Thus, “teachings of

references can be combined only if there is some suggestion or incentive to do so.” Id. Applicant respectfully asserts that the teachings of these references cannot be properly combined as there is no suggestion or incentive to do so within the references that is “clear and particular”. Moreover, Plummer and Williams fail to teach all of the limitations of these amended claims. The assertion in the Office Action that “it would have been obvious to one having ordinary skill in the art at the time this invention was made to construct a tape dispenser by Plummer with a pre-printed indicia as taught by Williams is to provide a means to convey the destination or room contents of the box in which the tape is applied” is completely unsupported and baseless. Once again, neither Plummer nor Williams disclose, teach or even infer means to convey the destination or room contents of the box using pre-printed indicia as recited in the claims of the present invention.

Although Williams discusses printing a destination address on the tape, this does not arise to providing repeatedly pre-printed indicia on a roll of adhesive tape indicating a single room or location within a house or office from which contents of the box originated or destined. Rather, the destination address is merely a street address or an office address within a building. The specific legend “bedroom, bathroom, kitchen, dining room, living room, garage, storage room, office, study, den, family room, utility room, etc.” do provide a non-obvious functional relationship with the tape as it not only illustrates that the contents of the box originated from the room or location pre-printed on the tape, but also instructs the mover to place this labeled box in such location in the new house or office. If this specific legend were merely a design consideration, stars, hearts, or non-sensical words could be utilized. However,

these design selections would convey absolutely nothing as to the origination of the contents of the box and the destination of the box from one house or office to another. Thus, Applicant believes that it is very clear that the indicia, as claimed, has a functional relationship with the tape which must be taken into account and which arises to patentable distinction between the other tapes and systems referenced by the Examiner.

Applicant's assertion that the claims are patentably distinct from the cited references is further supported by the pertinent case law. For example, in In re Miller, 164 USPQ 46 (CCPA 1969), the Examiner and the Board asserted that printed matter on measuring cups or measuring spoons were given no patentable weight. However, the Court of Customs and Patent Appeals reversed these decisions and found that the printed matter of Miller's invention was functionally related to the volume measuring device.

The Federal Circuit in In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), expounded upon the Miller decision. The sole difference between the appealed claims of the Gulack application and the Wittcoff reference resided in the content of the printed matter. In re Gulack, at 403. The Federal Circuit held that differences between the inventions and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. The Federal Circuit stated that "under section 103, the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claims must be read as a whole." The Federal Circuit further stated that "what is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability."

The Federal Circuit reversed the Board and the Examiner and held that there was a functional relationship between the printed matter and the substrate of the appealed claims, and that the relationship between the printed matter and the substrate differed from the relationship exhibited by the corresponding elements of the Wittcoff reference.

Similar to the In re Gulack case, the pre-printed indicia of Applicant's packaging tape is different in content than the printed matter of the Williams tape. Moreover, the relationship between the printed matter and the tape in the present application is substantially different than the relationship between the printed matter and the tape of the Williams reference. Instead of merely providing company name, address or warning messages, the pre-printed indicia of the tape of the present invention "indicates a room or location in a house or office from which contents of the box originated". That is, the pre-printed indicia assists the movers in determining which room or location in a house or office the contents originated and to which room or location in the new house or office the box should be placed. Such is simply not disclosed or even suggested in the Williams reference.

Claims 9 and 13-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kitagawa, in view of Plummer and Williams. Once again, Williams discloses a multiple layered laminated tape having a strength layer and a permeable layer which is suitable for printing and marking. Plummer discloses a multi-gang tape dispenser. Kitagawa discloses a process for packaging electrolytic capacitors within a box.

It is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art.

Life Technologies, Inc. v. Clontech Laboratories, Inc., 56 USPQ 2d 1186 (Fed. Cir. 2000).

It appears as if the Examiner has inappropriately used Applicant's claims as a framework from which to pick and choose among individual references to recreate the claimed invention. Of course, it is well-known that such hindsight is impermissible and strictly forbidden. It is also well-known that it is impermissible within the framework of 35 U.S.C. §103 to pick and choose from a reference only so much of it that will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. Bausch & Lomb v. Barnes Hing/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986).

Neither Kitagawa, Plummer or Williams (or the combination thereof), teach of utilizing adhesive tape having indicia repeatedly pre-printed thereon indicating a single room or location from which the articles were taken within a house or office or where the box or the articles is destined within the house or office, and which simultaneously seals and labels the boxes without the need to mark the tape or box with a writing instrument, as recited in the independent claims of the present invention.

The Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness as to the amended claims: that there must be some suggestion or motivation in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination. M.P.E.P. §2143.01 citing In re Mills, 16 USPQ 2d 1430 (Fed. Cir. 1990). Instead, it appears as if the Examiner is inappropriately using Applicant's claims as a framework from which to pick and choose among individual references, with complete disregard to the analogous nature of the references, to recreate the claimed invention. Of course, this is impermissible and strictly forbidden.

The present invention is directed to a packaging tape system and process for moving which assists the movers by simultaneously sealing and labeling a box with a single room or location within the house or office from which the contents of the box originated or destined within the house or office. Doing so without requiring the marking of the box or tape with a writing instrument, utilizing color coded tape, and printing indica representing a single room or location (which aids in viewing the information on the tape from a distance) is not taught whatsoever in the prior art cited up to this point by the Examiner. This arrangement overcomes many of the problems encountered in the prior art when packaging and moving boxes, as described in the application. In the rare case where the prior art does not appreciated the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. In re Nomiya et al., 184 USPQ 607, 612-613 (CCPA 1975).

In light of the foregoing arguments, Applicant respectfully requests that the currently pending claims 6-11, and 13-21, are patentably distinct from the cited references which have been improperly combined and do not teach all of the claim limitations of the independent claims.

IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

6. A packaging tape system, comprising:

multiple rolls of adhesive tape having a sufficient length to extend across a face of a box and seal two flaps of the box in a closed position; and indicia repeatedly pre-printed on each roll of the adhesive tape along the length thereof indicating a single room or location within in a house or office from which contents of the box originated or are destined within another house or office;

wherein each roll is of a distinctive color so as to be readily visually distinguishable from another roll indicating another room or location within the house or office; and

wherein the box can be sealed and labeled simultaneously without the marking the box or tape with a writing instrument.

7. The system of claim 6, wherein the pre-printed indicia relating to the single room or location of the house is selected from: a bedroom, a bathroom, a kitchen, a dining room, a living room, a garage, a storage room, an office, a study, a den, a family room and a utility room.

8. The system of claim 6, wherein the pre-printed indicia relating to the single room or location of the office is selected from: a breakroom, a conference room, a file room, a reception area, an office, a computer and a department.

9. A process for packaging articles to be moved, comprising the steps of:

supplying a moving box having opposed open flaps;

placing articles to be moved into the moving box;

closing the flaps toward one another; and

applying adhesive tape over substantially the length of opposing edges of the closed flaps to hold the flaps in a closed position, the adhesive tape having indicia repeatedly pre-printed thereon indicating a single room or location from which the articles were taken within a house or office, or where the

box of articles is destined within another house or office, whereby the moving box is sealed and labeled simultaneously without the need more marking the tape or the box with a writing instrument.

10. The process of claim 9, wherein the pre-printed indicia relating to the single room or location of the house is selected from: a bedroom, a bathroom, a kitchen, a dining room, a living room, a garage, a storage room, an office, a study, a den, a family room and a utility room.

11. The process of claim 9, wherein the pre-printed indicia relating to the single room or location of the office is selected from: a breakroom, a conference room, a file room, a reception area, an office, a computer and a department.

13. The process of claim 9, including the step of providing multiple rolls of adhesive tape, wherein the adhesive tape of each roll is of a distinctive color so as to be readily visually distinguishable from another roll indicating another room or location of the house or office.

14. A process for packaging articles to be moved, comprising the steps of:

supplying a moving box having opposed open flaps;

placing articles to be moved into the moving box;

closing the flaps toward one another;

providing multiple rolls of adhesive tape each having pre-printed indicia repeatedly thereon for indicating a single room or location from which the articles were taken within a house or office or representing the destination of the box of articles within another house or office, each roll being of a distinctive color so as to be readily visually distinguishable from another roll indicating another room or location of the house or office; and

applying adhesive tape from the dispensing roll indicating the room or location from which the articles within the box were taken over substantially the length of opposing edges of the closed flaps to hold the flaps in a closed

position, whereby the moving box is sealed and labeled simultaneously without the need to mark the tape or the box with a writing instrument.

15. The process of claim 14, wherein the pre-printed indicia relating to the single room or location of the house is selected from: a bedroom, a bathroom, a kitchen, a dining room, a living room, a garage, a storage room, an office, a study, a den, a family room and a utility room.

16. The process of claim 14, wherein the pre-printed indicia relating to the single room or location of the office is selected from: a breakroom, a conference room, a file room, a reception area, an office, a computer and a department.

17. A packaging tape system, comprising:

a roll of adhesive tape configured to extend across a face of a box and seal two flaps of the box in a closed position; and

indicia repeatedly pre-printed on the adhesive tape indicating a single room or location in a house from which contents of the box originated or are destined within another house, wherein the pre-printed indicia relating to the rooms and locations of the house is selected from: a bedroom, a bathroom, a kitchen, a dining room, a living room, a garage, a storage room, an office, a study, a den, a family room a utility room;

wherein the box can be sealed and labeled simultaneously without marking the box or tape with a writing instrument.

18. The system of claim 17, comprising multiple rolls of adhesive tape, each roll being of a distinctive color so as to be readily visually distinguishable from another roll of adhesive tape for indicating another room or location within the house or office.

19. A packaging tape system, comprising:

a roll of adhesive tape configured to extend across a face of a box and seal two flaps of the box in a closed position; and

indicia repeatedly pre-printed on the adhesive tape indicating single a room or location in an office from which contents of the box originated or are destined within another office, wherein the pre-printed indicia relating to the single room or location within the office is selected from: a breakroom, a conference room, a file room, a reception area, an office, a computer and a department;

wherein the box can be sealed and labeled simultaneously without marking the box or tape with a writing instrument.

20. The system of claim 19, comprising multiple-rolls of adhesive tape, each roll being of a distinctive color so as to be readily visually distinguishable from another roll of adhesive tape for indicating another room or location within the house or office.

21. A process for packaging articles to be moved from a first house to a second house, comprising the steps of:

providing multiple rolls of adhesive tape each having indicia repeatedly printed on a length thereof indicating a single room or location within the house, selected from: a bedroom, a bathroom, a kitchen, a dining room, a living room, a garage, a storage room, an office, a study, a den, a family room and a utility room, wherein each roll is of a distinctive color so as to be readily visually distinguishable from another roll indicating another room or location within the house ;

supplying at least one moving box having opposed open flaps;

placing articles within a room of the first house to be moved to the second house into the moving box;

closing the flaps of the box toward one another;

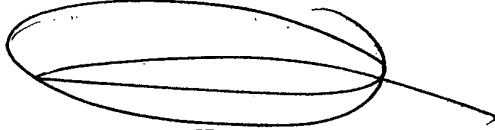
selecting the roll of adhesive tape having the single room repeatedly pre-printed thereon representing the room from the which the articles were taken;

applying the adhesive tape from the selected roll over substantially the length of opposing edges of the closed flaps to hold the flaps in a closed position, whereby the moving box is sealed and labeled simultaneously without the need to mark the tape or the box with a writing instrument; and

delivering the at least one sealed and labeled box from the first house to the second house and placing each sealed and labeled box in a corresponding room in the second house according to the indicia on the adhesive tape sealing the box.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP

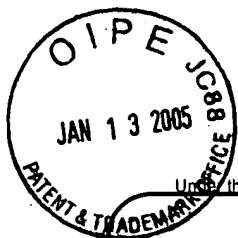
A handwritten signature in black ink, appearing to read 'Aaron T. Borrowman', enclosed within a hand-drawn oval.

Aaron T. Borrowman
Registration No. 42,348

ATB/maf
(Submitted in Triplicate)

Attachment: USPTO Fee

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TRANSMITTAL FORM

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Total Number of Pages in This Submission

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First Named Inventor Chris Kreutner

Art Unit 3611

Examiner Name Cassandra Davis

Attorney Docket Number SMART-38766

ENCLOSURES (Check all that apply)

- | | | |
|---|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to TC |
| <input checked="" type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
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| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name KELLY LOWRY & KELLEY, LLP

Signature

Printed name Aaron T. Borrowman

Date 01-07-2005

Reg. No. 42,348

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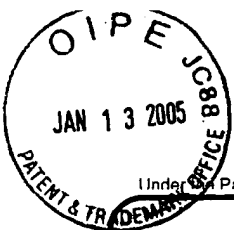
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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☒ Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$)
250.00**Complete if Known**

| | |
|----------------------|-----------------|
| Application Number | 09/934,777 |
| Filing Date | 08-21-2001 |
| First Named Inventor | Christ Kreutner |
| Examiner Name | Cassandra Davis |
| Art Unit | 3611 |
| Attorney Docket No. | SMART-38766 |

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☐ Deposit Account Deposit Account Number: _____ Deposit Account Name: _____

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☐ Charge fee(s) indicated below☐ Charge fee(s) indicated below, **except for the filing fee**☐ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17☐ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

| Application Type | FILING FEES | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
| | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | |
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | |
| Plant | 200 | 100 | 300 | 150 | 160 | 80 | |
| Reissue | 300 | 150 | 500 | 250 | 600 | 300 | |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity Fee (\$) |
|--|---------------------|-----------------------|
| Each claim over 20 (including Reissues) | 50 | 25 |
| Each independent claim over 3 (including Reissues) | 200 | 100 |
| Multiple dependent claims | 360 | 180 |
| Total Claims | Extra Claims | Fee (\$) |
| - 20 or HP = _____ x _____ = _____ | | |
| HP = highest number of total claims paid for, if greater than 20. | | |
| Indep. Claims | Extra Claims | Fee (\$) |
| - 3 or HP = _____ x _____ = _____ | | |
| HP = highest number of independent claims paid for, if greater than 3. | | |

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| | | | | |
|---------------------|--------------------|--|----------|---------------|
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Fees Paid (\$)

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| Signature | Registration No. (Attorney/Agent) 42,348 | Telephone 818-347-7900 |
| Name (Print/Type) Aaron T. Borrowman | | Date 01-07-2004 |

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